

## REMARKS

Claims 1, 2, 7-13,16-20 are pending. Claims 3-4, 6, 14-15 have been canceled. No claims have been withdrawn.

**Claims 1,2,6-8,10,12-13,17 and 20 stand rejected under 35 USC 102 as being anticipated by US Patent Publication No. 2003/0220691 (“Songer”)**

In formulating the final rejection, the Examiner does not find that the Songer reference possesses a shock-absorbing component tenaciously attached to the respective inner surface of each plate. Rather, the Examiner merely finds that “each peripheral surface of the shock-absorbing component is capable of being tenaciously attached to the respective inner surface of each plate.” (emphasis supplied).

Applicants respectfully traverse. In order to find anticipation, each and every element of the claimed invention be disclosed or described in a sole prior art reference. In re Paulsen 31 USPQ 2d 1671 (Fed. Cir. 1994). Accordingly, in order to defend the anticipation rejection, the Examiner must find that each peripheral surface of the shock-absorbing component in Songer is necessarily tenaciously attached to the respective inner surface of each plate.

Since the cited Songer reference does not explicitly state that such is the case, then anticipation can be found only if such tenacious adherence is the necessary result of its teachings. Under the principle of inherency, if a structure in the prior art necessarily functions in accordance with the limitations, the claim is anticipated. In re King 231 USPQ 136 (Fed. Cir. 1986). The mere fact that a certain thing may result from a given set of circumstances is insufficient to prove anticipation. The challenger is required to prove that a claim element allegedly inherent in a prior art reference is necessarily present in that reference, and that it would be so recognized by persons of ordinary skill in the art. Electro Medical Systems, S.A. v. Cooper Life Sciences Inc. 32 USPQ 2d 1017 (Fed. Cir. 1994). Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency... However, if the natural result flowing from the operation of the prior art teaching would necessarily result in achievement of each of the claim

limitations, then the claimed invention is anticipated. Scaltech Inc. v. Retec/Tetra, L.L.C. 51 USPQ 2d 1055 (Fed. Cir. 1999). Consistent with the law of inherent anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art. Hitzeman v. Rutter 58 USPQ 2d 1161 (Fed. Cir. 2001). Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art. Rosco, Inc. v. Mirror Lite Co. 64 USPQ 2d 1676 (Fed. Cir. 2002).

Applicants submit, and the Examiner appears to agree, that tenacious attachment of each peripheral surface of the shock-absorbing component to the respective inner surface of each plate, is not necessarily present in the teachings of Songer. Since this limitation is neither disclosed explicitly nor inherently necessarily present in Songer, Songer does not anticipate the claimed invention.

Moreover, the Examiner has incorrectly construed the law of anticipation. The Examiner summarizes anticipation law as follows:

...it is noted that the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. Kalman v. Kimberly Clark Corp. 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). In other words, the elastic shock absorbing ring of Songer et al. is capable of being tenaciously attached to the respective inner surface of each endplate (see paragraph 0062, particularly lines 4-7). Moreover, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires an ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

The Examiner has appeared to focus on “intended use” cases. However, application of these cases to the present situation appears to be inappropriate. “Intended use” cases reflect the situation in which a reference discloses each structural limitation of a product, but do not disclose an intended use of the product whose recitation is present in the claims. These cases are irrelevant to the present situation, wherein the “tenacious

adherence" limitation, which is a structural limitation and is not an intended use, is completely absent from the Songer reference. For this reason, the anticipation rejection must be withdrawn.

**Claims 9, 11 and 16 stand rejected as being unpatentable over Songer**

Since these claims depend from claim 1, and the "tenacious adherence" limitation is not disclosed, taught or suggested by Songer, this rejection should be withdrawn.

**Claims 18 and 19 stand rejected as being unpatentable over Songer in view of US Patent No. 6,749,635 ("Bryan")**

Since these claims depend from claim 1, and the "tenacious adherence" limitation is not disclosed, taught or suggested by Songer, this rejection should be withdrawn.

In addition, please provide any additional extensions of time which may be necessary and charge any fees which may be due to Deposit Account No. 10-0750, but do not include any payment of issue fees.

Should there be any remaining or further questions, the Examiner is requested to place contact the undersigned directly.

Respectfully submitted,

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